

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 09/728,340 Confirmation No.: 5053
Applicant : Tom Vicknair
Filed : December 1, 2000
Title : ELECTRONIC CHECK PRESENTMENT SYSTEM AND
METHOD HAVING AN ITEM SEQUENCE CAPABILITY
TC/Art Unit : 3628
Examiner: Harish T. Dass

Docket No. : 72167.000253
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REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette. Applicants hereby request a pre-appeal brief conference in the above-referenced case.

This application is appropriate for a pre-appeal brief conference. A brief history of this application and why Applicants believe that an appeal will succeed are set forth below. This application was filed December 1, 2000. The claims were rejected under 35 U.S.C. § 102 by U.S. Patent No. 5,930,778 to Geer ("Geer") and under 35 U.S.C. § 103(a) by Geer in view of U.S. Patent No. 5,678,046 to Cahill *et al* ("Cahill *et al*") in Office Action mailed June 16, 2004. The claims were rejected under 35 U.S.C. § 103(a) under Geer, U.S. Patent No. 5,532,464 to Josephson ("Josephson") in view of Cahill *et al* in Final Office Action mailed February 4, 2005. In response, Applicants filed a Request for Continued Examination application on May 4, 2005. The claims were rejected under 35 U.S.C. § 103(a) by Geer, Josephson, Cahill *et al* and U.S. Patent No. 5,502,576 to Ramsay *et al* ("Ramsay *et al*") in Office Action mailed August 23, 2005.

In addition, claims 1-6 and 7-10 were rejected under 35 U.S.C. § 112, first paragraph. In the Final Rejection mailed February 28, 2006, the claims were rejected under 35 U.S.C. § 103(a) by the same four reference combination, Geer, Josephson, Cahill *et al* and Ramsey *et al*. In addition, the rejection under 35 U.S.C. § 112, first paragraph was withdrawn and a new objection to the specification was raised for the first time. Applicants responded on April 28, 2006 to address the new objection to the specification and provide convincing arguments as to why the objection was improper and should be withdrawn¹. The Advisory Action on May 23, 2006 maintained the four reference combination under 35 U.S.C. § 103(a) but failed to make any mention of Applicants' arguments against the objection to the specification.

Each of the rejections failed to properly address each and every claim limitation, and failed to provide a proper statement of motivation. In sum, a *prima facie* case of obviousness has yet to be set forth for any of the office actions in this application, including the present Office Action dated February 28, 2006. Accordingly, rather than proceeding with an expensive appeal, Applicants respectfully request that the Office, following consideration of the remarks below, issue a Panel Decision allowing the application based on existing claims and closing the prosecution record. If the Panel declines to issue such a finding, then Applicants request that the Office either issue a proper office action stating a thoughtful basis for rejection or allow this application to proceed to appeal.

On the merits, claims 1-6, 8-10, 36-41 and 43-45 are currently rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Geer in view of Josephson, Cahill *et al* and Ramsay *et al*. That rejection is flawed for at least the following reasons. The Office Action admits the major deficiencies of Geer. More specifically, Geer fails to show at least the steps of

¹ See pages 6-7 of the Response to Office Action, dated April 27, 2006.

“correlating the first and second records” and “discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number *wherein the second records and the digital images are linked to the first records by the first item sequence number.*” In addition, Geer further fails to show “receiving the paper-based banking transactions after having received the ECP file.”² The excerpt of the Geer disclosure relied upon by the Office Action fails to show that paper-based banking transactions are received *after* the ECP file. This limitation is clearly lacking in Geer. Further, none of the applied references disclose at least this missing feature.

The Office Action relies upon Josephson, Cahill *et al* and Ramsay *et al* for the admitted major shortcomings of Geer. Based on various deficient excerpts of the three secondary references, the Office Action summarily concludes that it would have been obvious to combine the disclosures of Geer and Ramsay *et al* “to capture the image of an item and assign a sequence number to the image,” without providing a basis as to why one of ordinary skill in the art would be motivated to modify the system of Geer to include this additional feature. In addition, the Office Action concludes that it would have been obvious to combine Geer and Ramsay *et al* with Josephson “to relate the image sequence number to serial number of the time (cross reference),” without providing a basis as to why one of ordinary skill in the art would be motivated to further modify the system of Geer combined with Ramsay *et al* to include the additional feature as allegedly taught by Josephson. Further, the Office Action concludes that it would have been obvious to combine Geer and Ramsay *et al* with Josephson and Cahill *et al* “for improved database managing of document retrieval using indexed record,” without any explanation why the additional features would be desirable in the proposed combination of references. To date,

² Office Action mailed February 4, 2005 admits that Geer does not disclose this limitation. See page 3.

the Office Action has failed to provide a proper statement of motivation for combining the *four* disparate references. Instead, the alleged statements of motivation are based on improper hindsight.

Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *See In re Lee*, 277 F.3d 1338, 1343-46, 61 U.S.P.Q.2d 1430; *In re Rouffett*, 149 F.3d 1350, 1355-59, 47 U.S.P.Q.2d 1453.

The Office Action has failed to set forth a *prima facie* case of obviousness for the independent claims. Specifically, when a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the art would have been motivated to modify the primary reference in the exact manner proposed. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000). In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention.

In the present case, the Office Action's justifications for combining Geer, Josephson, Cahill, and Ramsay have absolutely nothing to do with the admitted deficiencies of Geer. As recognized by the Office Action, Geer fails to show at least the steps of "correlating the first and second records" and "discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number." To properly modify Geer to correct for these major deficiencies, the Office Action has the burden to show some motivation why providing those elements would have overcome some perceived problem with Geer. Any such motivation is completely lacking.

The mere fact that Geer, Josephson, Cahill and Ramsay can be somehow combined and modified does not render the resultant modification obvious unless there is a suggestion or motivation found somewhere in the prior art regarding the desirability of the combination or modification. See M.P.E.P § 2143.01; see also *In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); *In re Fritz*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventors have done. The Examiner has clearly failed to reach the initial burden. Therefore, the pending claims are patentable over the prior art and are believed to be in condition for allowance. Thus, an appeal on the current rejections will certainly succeed, but the time and expense in preparing an appeal brief on these issue should not be borne by Applicants when the grounds are so clearly improper. Additionally, where there have already been four poorly-constructed and ultimately withdrawn prior rejections, Applicants deserve to finally receive a notice of allowance or a proper, fully-articulated rejection on the best art the Examiner can locate, so that Applicants can work with the PTO to bring this meritorious application to allowance without further delay.

Respectfully submitted,


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